IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:
SLOO, MARSHALL A.

Serial No.: 09/259,427

Filed: February 26, 1999

Title:
INCIDENT REPORTING SYSTEM
AND METHOD

Docket No.: 27080

Group Art Unit No.: 3628

Examiner: Nguyen, Nga B.

APPEAL BRIEF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:
SLOO, MARSHALL A.

Serial No.: 09/259,427

Filed: February 26, 1999

Title:
INCIDENT REPORTING SYSTEM
AND METHOD

Docket No.: 27080

Group Art Unit No.: 3628

Examiner: Nguyen, Nga B.

Assistant Commissioner of Patents
Washington, D.C. 20231

APPLICANT'S BRIEF ON APPEAL

In response to the Office action dated October 7, 2003, Applicant's Brief on Appeal in accordance with 37 C.F.R. §1.192 is hereby submitted, in triplicate, and reinstatement of the appeal is hereby requested. The Examiner's rejections of the claims as last amended are herein appealed and allowance of said claims is respectfully requested.

As the fee required by 37 C.F.R. §1.17(c) was previously submitted and prosecution was reopened prior to a decision on the merits by the Board of Patent Appeals and Interferences, Applicant believes no fee is currently due. See MPEP §1208.03. However, any fee which is due in connection with this appeal should be applied against Deposit Account No. 19-0522.

Respectfully submitted,

By_____

Thomas B. Luebbering, Reg. No. 37,874
HOVEY WILLIAMS LLP
2405 Grand Boulevard, Suite 400
Kansas City MO 64108
(816) 474-9050
ATTORNEY FOR APPLICANT

Following are the requisite statements under 37 C.F.R. §1.192:

I. Real Parties in Interest

Marshall A. Sloo is the sole inventor of the claimed invention and the real party in interest.

II. Related Appeals and Interferences

No related appeals or interferences are known to Appellant which may directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The application, as originally filed, contained sixteen (16) claims, with claim 1 being the only independent claim.

A first Office action was mailed on September 25, 2001, rejecting claims 1-16 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,043,813 to Stickney, in view of Official Notice taken by the Examiner. In response, a first amendment was filed wherein claim 1 was amended in order to highlight differences between the present invention and the prior art cited. In the first amendment, supporting arguments were made, the Official Notice was traversed, and applicant requested proof of the Official Notice. Additionally, four (4) new claims, claims 17-20, were added, with claims 17 and 20 being independent.

A second Office action was mailed on March 12, 2002, rejecting claims 1-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,065,000 to Jensen, in

view of Official Notice taken by the Examiner. The second Office action was made final. In response, a request for reconsideration was filed wherein arguments were made highlighting differences in the claims and the prior art cited. In the request for reconsideration, the Official Notice was again traversed and Applicant again requested proof of the Official Notice.

An advisory action was mailed on May 22, 2002, responding to arguments regarding claims 1, 2, and 6-10. No mention was made of claims 3-5 and 11-20. In response, a first Notice of Appeal was mailed on July 12, 2002. A first appeal brief was mailed on September 6, 2002, hereby incorporated into the present appeal brief by reference.

A third Office action was issued February 3, 2003, thereby reopening prosecution and rejecting claims 1-20 under 35 U.S.C. §112, second paragraph, citing language that was in the claims as originally filed and not previously mentioned. In a telephonic interview conducted on February 12, 2003, the Examiner agreed to file an Examiner's amendment and issue a notice of allowance as no other grounds for rejection existed. Over the course of the next three months, the Examiner delayed and finally recanted. Therefore, on May 2, 2003, Appellant was forced to file a second amendment in order to overcome the §112 rejections.

A fourth Office action was issued October 7, 2003 rejecting claims 1-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,510,978 to Colgan, in view of U.S. Patent No. 6,173,284 to Brown and statements by the Examiner of what is well known in the art. In response, the present appeal brief is hereby submitted and reinstatement of the appeal is hereby requested.

Claims 1-20 are currently pending and the rejections of these claims are appealed.

IV. Status of Amendments

All amendments submitted by the Appellant have been entered.

V. Summary of the Invention

The present invention concerns a computer based method and program for receiving, collecting, and processing incident reports provided by witnesses. See page 1, lines 31-33. The method broadly comprises the steps of receiving information directly into a computer system from a witness who observed an incident committed by an offender, prompting the witness to enter certain types of information about the incident, selecting an authority based on the information entered by the witness, and sending the incident report to the selected authority so that the authority can respond to the incident report. The present invention encourages witnesses to submit incident reports because it does not require them to know or identify to whom the incident report should be sent. See page 2, lines 1-12. After the witness has entered information into the incident report, the authority to whom the incident report should be sent is selected. The authority may be selected by the witness, automatically by the program, or a combination of the two. See page 6 lines 25-32. Thus, if the witness does not know who the appropriate authority is, the program may automatically select the authority based on the information entered by the witness. Additionally, if the witness requests to send the incident report to a particular authority, the program may evaluate the information entered by the witness and determine that the incident report should also be sent to another authority. See page 7, lines 2-8.

The present invention expressly identifies and seeks to address a particular problem in the prior art. Specifically, people often do not report incidents to the appropriate authority, making it difficult for the appropriate authority to act on the incidents.

Thus, it will be appreciated that the present invention's field of endeavor relates to a method of receiving incident reports provided by witnesses, selecting an appropriate authority based on information in the incident reports, and sending the incident reports to the appropriate authority so that they may be acted upon in an efficient and more convenient manner than is provided for by the prior art.

VI. Issue

Whether the Examiner has established a *prima facie* case of obviousness as required by 35 U.S.C. §103.

VII. Grouping of Claims

In accordance with 37 C.F.R. §1.192(c)(7), it shall be noted that the claims do not stand or fall together. Specifically, the appellant requests that claims 1-6, 8, 11-15 and 17 be grouped as Group 1, claims 7, 18, and 20 be grouped as Group 2, and claims and 9, 10, and 19 be grouped as Group 3. Arguments in support of the requested grouping can be found below.

VIII. Arguments and Authorities

A. Arguments in support of the requested grouping.

As discussed above, the Appellant requests that claims 1-6, 8, 11-15 and 17 be grouped as Group 1, claims 7, 18, and 20 be grouped as Group 2, and claims and 9, 10, and 19 be grouped as Group 3. Thus, Group 1 consists of independent claims 1 and 17 and dependent claims 2-6, 8, and 11-15, which depend direct or indirectly from claim 1. Claim 1 recites "selecting an authority to whom the incident report should be sent, wherein the authority is selected based at least in part on information provided by the witness". Similarly, claim 17 recites "selecting an authority to whom the incident report should be sent, wherein the authority is selected based at least in part on information entered by the witness".

Therefore, Group 1 consists of claims directed to a computer-based method that includes selecting an appropriate authority based at least in part on information entered by a witness. As stated in response to the first Office action, the present invention allows the witness to prepare an incident report first. Then, based on the information supplied in the incident report, select the appropriate authority. The witness is in a better position to select the appropriate authority with the incident report prepared and all known facts laid out. In the broadest sense of Group 1, anyone may select the appropriate authority, provided the appropriate authority is selected based upon information entered by the witness.

Group 2 consists of independent claim 20 and dependent claims 7 and 18, which depend direct or indirectly from claim 1 or 17, respectively. Claim 20 recites "selecting an authority to whom the incident report should be sent, wherein the authority is selected by the computer system based at least in part on information entered by the witness". Claim 7 recites "wherein the authority is automatically selected by the computer system based

on information entered into the incident report by the witness". Similarly, claim 18 recites "wherein the authority is selected by the computer system based on information entered into the incident report by the witness".

Therefore, Group 2 consists of claims directed to a computer-based method utilizing a computer system that can analyze incident reports and select an appropriate authority based at least in part on information entered into the incident reports by a witness. Group 2 necessarily requires that the computer system posses more than mere message sharing capabilities. The computer system of Group 2 must actually analyze each incident report and select the appropriate authority to whom the incident report should be sent, based upon such analysis.

Group 3 consists of dependent claims 9, 10, and 19, which depend directly or indirectly from claim 1 or 17. Claim 9 recites "receiving into the computer system an action report from the authority explaining the action the authority took in response to the incident report". Claim 10 depends from claim 9. Claim 19 recites "receiving an action report from the authority explaining what action was taken in response to the incident report".

Therefore, Group 3 consists of claims directed to a computer-based method that receives action reports from an authority explaining action taken by the authority and prompted by the incident report. The authority of Group 2 must not only receive the incident report, but they must also take action in response to the incident report and provide the action report explaining the action taken.

Thus, Group 2 is significantly narrower than and would be patentable over Group 1, if Group 1 were to be used as a reference against Group 2. Similarly, Group 3 is significantly narrower than and would be patentable over Group 1, if Group 1 were to be

used as a reference against Group 3. Additionally, both Group 2 and Group 3 would be patentable over each other, if either one were to be used as a reference against the other.

B. The Examiner has failed to establish a *prima facie* case of obviousness as required by 35 U.S.C. 103(b), specifically with regard to identifying prior art that teaches all the claim limitations of the present invention.

The Examiner's current rejections of claims 1-7 and 9-20 under 35 U.S.C. §103(a) is based on combination of a two prior art references, Colgan and Brown. Specifically, the Examiner's rejections rely on two separate and compounded determinations of obviousness. According to the Examiner, the present invention is *obvious* in light of the combination of Colgan and Brown wherein the suggestion or motivation for the combination of Colgan and Brown is *obvious* given the knowledge of one with ordinary skill in the art. The Examiner's mere conclusory assertions of obviousness, without more, are not sufficient to establish a *prima facie* case of obviousness or to shift the burden to the applicant to refute, in this case, two negative propositions.

In rejecting the claims under 35 U.S.C. §103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. If the Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. See *In re Rijckaert,* 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). MPEP §706.02(j) addresses rejections under 35 U.S.C. §103 over prior art and sets forth three criteria that must be met in order to establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either

in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all the claim limitations. See MPEP §706.02(j), citing *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Only if the Examiner's burden is met does the burden shift to the applicant to provide evidence to refute the rejection.

Specifically, as stated in MPEP §2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

Claim 1 recites "receiving into a computer system an incident report ***directly from a witness***" (emphasis added). As discussed at great length in each amendment and the first appeal brief, incorporated herein by reference, the method of the present invention receives the incident report directly from the witness into the computer system. There simply is no middle step. The witness accesses the computer system and enters information into the report, without filling out any paper forms or having a trained computer operator enter his or her information into a specialized court reporting application.

On page 2, count 5, of the fourth Office action, the Examiner stated that Colgan discloses "receiving into a computer system an incident report directly from a witness" and cited Colgan's disclosure of "UF-61" reports. However, UF-61 reports are well known paper forms that witnesses fill out with pen in hand, in order to report a crime. While

information in those reports may be transcribed or scanned into a computer system, there is nothing computerized about how a witness submits them. In fact, each and every prior art reference made of record suffers from the same deficiency. There simply has been no identification of prior art that discloses a witness entering an incident report directly into a computer system. This has been one of Appellant's contentions from the very first amendment. Rather than directly address this contention, the Examiner has continuously chosen to side-step the issue and cite new art which is no more relevant than the existing are of record.

Appellant asserts that there is no police station, or other 'authority', that allows witnesses to walk-in, sit down at a computer system, and enter an incident report directly into that computer system. If there is such a modern facility, that facility surely was not operational nearly four years ago. Thus, the prior art simply does not teach or suggest receiving into a computer system an incident report directly from a witness, as recited in Group 1.

On page 3, count 5, of the fourth Office action, the Examiner acknowledged that "Colgan does not disclose selecting an authority to whom the incident report should be sent, wherein the authority is selected based at least in part on information provided by the witness and sending the incident report to the selected authority so that the authority can respond to the incident report". However, the Examiner also stated that "Brown discloses selecting an authority to whom the incident report should be sent" and cited column 12, lines 7-20.

As noted in the cited portion, Brown simply discloses a system that can "automatically monitor a police database at a user-defined frequency to identify a user-

desired crime profile". More specifically, in column 7, lines 31-44, Brown discloses a "query information form 64 [that] comprises dialog boxes in which the user may enter information such as request data which defines the crime profile which the user wishes to monitor, a frequency term which defines the frequency at which a search is performed against a police records database". It should be obvious that Brown discloses a simple database query that queries a previously populated database. That database is "a police records database". Thus, in order for Brown's query to return ***any*** results, a report must have previously been made to the police and entered into the "police records database". In fact, Brown discloses no other database, much less another authority. Thus, there is no need to select an authority. As a result, Brown discloses no method of "selecting an authority to whom the incident report should be sent".

Furthermore, simple database queries, such as Brown's, are simply not analogous to the present invention, which in the closest possible analogy, decides which database to populate. The prior art example critically depends upon the proper database being populated, rather than selecting the proper database to populate. These are two separate and distinct functions.

More specifically, in database queries, such as Brown's, there just is no selecting of an authority. Rather, the query simply selects records, or reports, that meet a specified criteria. The fact that one officer can have different criteria than another, thereby resulting in different reports being requested by different officers, is immaterial for several reasons. First, both officers are accessing the exact same database and both officers represent the exact same authority, and therefore there is no more than one authority to begin with, much less any need to select an authority. Second, as discussed above, the ***only***

selection that is conducted is selecting records that have already been reported to the authority. Selecting records is simply not analogous to selecting an authority. Third, selecting records is a pull-type function, in that selecting records pulls information from a previously populated database. In contrast, selecting an authority is a push-type function, in that selecting an authority pushes information to the selected authority. Pull and push functions are distinct and are often conducted by different interfaces, if not different applications.

Finally, as discussed above, Brown simply discloses a police records database. Since Brown discloses no other 'authority', the witness must have selected the authority long before and independently of filling out the incident report. In fact, each and every prior art reference made of record suffers from the same deficiency. This has been one of Appellant's contentions from the very first amendment. Thus, as argued in every amendment, the request for reconsideration, and the first appeal brief, selecting the authority, as taught by the prior art made of record, cannot be based on the incident report.

As the Examiner has acknowledged that Colgan does not disclose selecting an authority and Brown does not disclose selecting an authority, as discussed above, the prior art simply does not teach or suggest selecting an authority based on information provided by the witness, as recited in Group 1.

It should be noted that unsupported rejections, such as this, have plagued this case from the first Office action. For example, as noted in the first appeal brief, the first two Office actions contained Official Notice that was never supported. Furthermore, on page 3, count 6, of the second Office action and page 2, count 3, of the advisory action, the Examiner acknowledged that "Jensen does not disclose the witness selects an authority

to whom the incident report should be sent, wherein the authority is selected based at least in part on information provided by the witness". In the second Office action, the Examiner again took unsupported Official Notice. In the advisory action, the Examiner cited Horovitz as a failed attempt to support the Official Notice. As discussed in the first appeal brief, Horovitz teaches of a system where a message sender knows to whom a message should be sent, but may need help in deciding how and in what form to send the message. Horovitz does not teach or suggest "selecting an authority". Each time Appellant addressed a rejection, the Examiner simply side-stepped and issued another unsupported rejection citing new art. This is clearly not expeditious or efficient examination.

With respect to Group 2, a witness using the present invention simply enters whatever information they have and the method of the present invention then automatically selects the authority, without requiring the user to configure any query. For example, claim 7 recites "wherein the authority is automatically selected by the computer system based on information entered into the incident report by the witness". This interpretation is further supported by the summary of the invention given above and the specification as originally filed.

On page 4, count 5, of the fourth Office action, the Examiner incorrectly stated that "Brown discloses the authority is automatically selected by the computer system based on information entered into the incident report by the witness". As discussed above Brown discloses no such thing. Rather, Brown discloses a simple database query that selects records instead of an authority. In fact, Brown's system doesn't even select the records automatically, at least not without user intervention. As discussed above the user must

configure the query by entering request data, in order to initiate Brown's selection of the records.

As the Examiner has not even alleged that Colgan discloses automatically selecting an authority and Brown does not disclose automatically selecting an authority, as discussed above, the prior art simply does not teach or suggest automatically selecting an authority based on information provided by the witness, as recited in Group 2.

With respect to Group 3, claim 19 recites "receiving an action report from the authority explaining what action was taken in response to the incident report and allowing the witness to view the action report". Claims 9 and 10 recite "receiving into the computer system an action report from the authority explaining the action the authority took in response to the incident report" and "storing the action report along with the incident report in a file accessible by the computer system", respectively. Claim 9 and 10 depend from claim 1 which recites "receiving into a computer system an incident report directly from a witness". Thus, the computer system of claims 9 and 10 is accessible to the witness, thereby allowing the witness to view the action report.

On page 4, count 5, of the fourth Office action, the Examiner stated that "Colgan discloses receiving into the computer system an action report from the authority explaining the action the authority took in response to the incident report and storing the action report along with the incident report in a file accessible by the computer system". The distinction is that the Examiner has again overlooked the fact that the databases in both Colgan and Brown are both essentially police records databases, which are inaccessible to witnesses and any other user except police officers. While a witness may fill out a paper report, the witness is not directly accessing any computer system, as required by the claims of Group

3. In fact, none of the prior art references made of record discloses or suggests a witness directly entering an incident report into any computer system, as required by the claims of Group 3. Thus, the prior art simply does not teach or suggest automatically selecting an authority based on information provided by the witness, as recited in Group 3.

As discussed above, the Examiner has repeatedly failed to cite prior art references that teach all the claim limitations of the present invention. Thus, the Examiner has continuously failed to establish a *prima facie* case of obviousness and the rejections of Groups 1, 2, and 3 under 35 U.S.C. §103 cannot be sustained.

C. Conclusion

The Examiner's rejections of claims 1-20, Groups 1-3, under 35 U.S.C. §103 failed to establish a *prima facie* case of obviousness. Specifically, the Examiner has failed to cite references that teach all claim limitations of the present invention. Obviousness assertions are always problematic as the Examiner has the benefit of a blueprint in the form of the specification of the invention, in which light even an exceedingly complex solution may seem easy or obvious. It is against exactly these facts that the court sought to protect when it admonished against impermissible hindsight reconstruction. If the Examiner's mere conclusory assertion of obviousness were sufficient on which to base a rejection, then the most subjective and weakest of all grounds for rejection becomes the most difficult to surmount. This is the reason the court requires that the Examiner identify prior art that teaches all the claim limitations of the claimed invention, in order to establish a *prima facie*

case of obviousness. As the Examiner has failed to establish a *prima facie* case of obviousness, the rejections under 35 U.S.C. §103 cannot be sustained.

Accordingly, reversal of the Examiner's rejections is proper and such favorable action is solicited.

Respectfully submitted,

By_____

Thomas B. Luebbering, Reg. No. 37,874
HOVEY WILLIAMS LLP
2405 Grand Boulevard, Suite 400
Kansas City MO 64108
(816) 474-9050
ATTORNEY FOR APPLICANT

IX. Appendix

Currently pending claims 1-20 read as follows.

1. A computer-based method of collecting and processing incidents observed by witnesses comprising the steps of:

receiving into a computer system an incident report directly from a witness who observed an incident committed by an offender;

prompting the witness to provide certain types of information about the incident;

selecting an authority to whom the incident report should be sent, wherein the authority is selected based at least in part on information provided by the witness; and

sending the incident report to the authority so that the authority can respond to the incident report.

2. The method as set forth in claim 1, the incident being selected from the group consisting of a criminal act, a legal violation, a sale of a defective product, and a rendering of unsatisfactory service.

3. The method as set forth in claim 1, further including the step of prompting the witness to enter into the incident report identification information identifying the offender.

4. The method as set forth in claim 1, further including the step of receiving additional identification information identifying the offender and adding the additional identification information to the incident report.

5. The method as set forth in claim 4, the additional information being obtained by searching files accessible by the computer system based on the identification information entered by the witness.

6. The method as set forth in claim 4, the additional information being obtained by receiving the additional information from the authority based on the information entered by the witness.

7. The method as set forth in claim 1, wherein the authority is automatically selected by the computer system based on information entered into the incident report by the witness.

8. The method as set forth in claim 1, wherein the authority if selected by the witness.

9. The method as set forth in claim 1, further including the step of receiving into the computer system an action report from the authority explaining the action the authority took in response to the incident report.

10. The method as set forth in claim 9, further including the step of storing the action report along with the incident report in a file accessible by the computer system.

11. The method as set forth in claim 1, wherein the incident reports from a plurality of different witnesses are received in the computer system.

12. The method as set forth in claim 11, further including the step of storing the incident reports in a searchable database.

13. The method as set forth in claim 12, further including the step of permitting persons to access the searchable database to view the incident reports.

14. The method as set forth in claim 13, further including the step of receiving additional incident information from the persons that access the searchable database and adding the additional incident information to the incident reports to assist the authorities.

15. The method as set forth in claim 14, further including the step of sending the additional identification information to the witness.

16. The method as set forth in claim 15, further including the step of prompting the witness to update the incident report based on the additional identification information.

17. A computer-based method of collecting and processing incidents observed by witnesses comprising the steps of:

receiving into a computer system an incident report directly from a witness who observed an incident committed by an offender;

prompting the witness to enter certain types of information about the incident into the computer system, the information including identification information identifying the offender;

selecting an authority to whom the incident report should be sent, wherein the authority is selected based at least in part on information entered by the witness; and

sending the incident report to the authority so that the authority can respond to the incident report.

18. The method as set forth in claim 17, wherein the authority is selected by the computer system based on information entered into the incident report by the witness.

19. The method as set forth in claim 17, further including the steps of receiving an action report from the authority explaining what action was taken in response to the incident report and allowing the witness to view the action report.

20. A computer-based method of collecting and processing incidents observed by witnesses comprising the steps of:

receiving into a computer system an incident report directly from a witness who observed an incident committed by an offender, wherein the witness does not know to whom the incident report should be sent;

prompting the witness to enter certain types of information about the incident into the computer system, the information including identification information identifying the offender;

selecting an authority to whom the incident report should be sent, wherein the authority is selected by the computer system based at least in part on information entered by the witness;

sending the incident report to the authority so that the authority can respond to the incident report;

receiving an action report from the authority explaining what action was taken in response to the incident report; and

storing the action report in a searchable database.